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10/541,401

07/01/2005

Thomas Falck

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

AFSHAR, KAMRAN

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

08/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,401

Applicant(s)

FALCK ET AL.

Examiner

Kamran Afshar, 571-272-7796

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/01/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/05/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

CFR 1.78(a) (iii) requires the sentence in any non-provisional application:

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

Appropriate correction is required.

Claim Objections

2. Claims 1-9 are objected to because of the following informalities: In order to clarify the claimed limitations, the following claims should be amended as:

Claim 1, line 2, "at least one slave terminal" should be --said at least one slave terminal--.

Regarding claim 1, line 2, recites word(s) "at least one slave terminal" which is not clear if it is the same "at least one slave terminal " as recited in line 1. Therefore it is not clear as to what are positively claimed.

Regarding claim 2, line 2, "a terminal" should be -- said terminal--.

Regarding claim 3, line 2, recites word(s) "a terminal" should be -- said terminal--.

Regarding claim 4, line 3, recites word(s) "another terminal" should be --said another terminal--.

Regarding claim 5, line 1, recites word(s) "a slave terminal" should be -- said slave terminal--.

Regarding claim 6, line 1, recites word(s) "a terminal" should be -- said terminal--.

Regarding claim 6, line 5, recites word(s) "a terminal" should be -- said terminal--.

Regarding claim 7, line 3, recites word(s) "at least another terminal" should be -- said at least another terminal--.

Regarding claim 8, line 2, recites word(s) "a terminal" should be -- said terminal--.

Art Unit: 2617

For example:

Examiner very kindly invites the applicant to **insert the word "said" or "the" before the word(s)** "at least one slave terminal as recited in line 2 of claim 1. However, for the purpose of the examination, it is understood that both "at least one slave terminal" in lines 1 and 2 of the claim 1 are the same.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10541420. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations recited in the present application are transparently found the copending application 10541420 with obvious wording variations, Take an example of comparing claim 1 of pending application and claims 1 and 2 of copending application 10541420:

| Pending Application 10541401 | Co-pending application 10541420 |
|---|---|
| 1. A network having at least one slave terminal and a master terminal connected thereto that is | 1. A network having at least one slave terminal and a master terminal connected thereto that is |

Art Unit: 2617

| | |
|---|---|
| provided for instructing at least one slave terminal to check for inquiries for at least another terminal to be incorporated in the network, | provided to issue request to at least one slave terminal to search for at least one other terminal to be incorporated in the network, |
| wherein the instructed slave terminal, once it has detected a terminal that has not yet been incorporated is provided to forward the received search request to the master terminal | wherein a non-incorporated terminal is provided for transmitting a response to the requesting slave terminal after receiving a request and wherein the request slave terminal is provided for forwarding the response to the master terminal. |
| and the master terminal, once it has received the search request from the slave terminal is provided to set up a connection with the terminal that has not yet been incorporated. | 2. A network as claimed in claim 1, characterized in that, after receiving a response of a hitherto non-incorporated terminal, the master terminal is provided for setting up a connection to said terminal under certain condition. |

Therefore, the limitations in copending Application No. 10541420 encompassed in claimed limitation of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

5. Upon filing a suitable Terminal Disclaimer and proper overcome of the **Double Patenting rejection, and Objections** as discussed above in items 1-4, Claims 1-9 would be allowed.

The following is an examiner's statement of reasons for allowance: 1-9.

With respect to claim 1, Olkkanen (U.S. Patent 6,842,460 B1) is the closest prior art to the application invention which discloses a network having at least one slave terminal and a master terminal

Art Unit: 2617

(See Olkkanen e.g. slave device 106, master device 104, of Fig. 1A) connected thereto (See Olkkanen e.g. link 107 between 104 and 106 of Fig. 1A), at least one slave terminal (See Olkkanen e.g. slave device 106 of Fig. 1A) to check for inquiries (See Olkkanen e.g. page scan, Co. 2, Lines 31-32, also see 130 of Fig. 1B, Co. 6, Lines 4-7) for at least another terminal (See Olkkanen e.g. 100 of Fig. 1A, inquiry device or responding device, Co. 2, Lines 30-33 or searching for other devices, co. 2, Lines 17-18).

Rune (U.S. Pub. No.: 2003/0012173 A1) discloses Coordinated inquiry and page procedures in an ad-hoc wireless network (See Title, Abstract).

However, the prior art of record fails to disclose singly or in combination or render obvious that instructing at least one slave terminal to check for inquiries for at least another terminal to be incorporated in the network, wherein the instructed slave terminal, once it has detected a terminal that has not yet been incorporated is provided to forward the received search request to the master terminal and the master terminal, once it has received the search request from the slave terminal is provided to set up a connection with the terminal that has not yet been incorporated.

With respect to claim 9, the prior art of record fails to disclose singly or in combination or render obvious that to instruct at least one slave terminal to check inquiries for at least another terminal to be incorporated in the network, wherein the terminal acting as a slave terminal is provided following detection of an as yet non-incorporated terminal to forward the received inquiry to the master terminal and the terminal acting as a master terminal is provided following receipt of the inquiry from the slave terminal to set up the connection with the as yet non-incorporated terminal.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- | | |
|---|--|
| a) Young (U.S. 7,161,923 B2). | d) Fujioka (U.S. Pub. No.: 2002/0193073 A1). |
| b) Chen (U.S. Pub. No.: 2005/0141562 A1). | e) Kita (U.S. Pub. No.: 2203/0054821 A1). |
| c) Aggrawal (U.S. 6,876,643 B1). | d) Larsson (WO 01/41377 A1). |

Art Unit: 2617

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (571) 272-7796. The examiner can be reached on Monday-Friday.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, **Eng, George** can be reached @ (571) 272-3984. The fax number for the organization where this application or proceeding is assigned is **571-273-8300** for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kamran Afshar